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#5

In re Application of  
Nicholas BACHYNSKY and Woodie ROY  
Application No. 09/744,622  
PCT No.: PCT/US99/16940  
Int. Filing Date: 27 July 1999  
Priority Date: 27 July 1998  
Attorney Docket No. HO-P01615W00  
For: CHEMICALLY INDUCED INTRACELLULAR  
HYPERTHERMIA

DECISION REFUSING

STATUS

UNDER 37 CFR 1.47

This decision is in response to applicant's petition under 37 CFR 1.47(b), filed 05 September 2001.

#### BACKGROUND

On 27 July 1999, applicants filed international application PCT/US99/16940, which claimed a priority date of 27 July 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 February 2000. A Demand for international preliminary examination, in which the United States was elected, was timely filed on 23 February 2000. Accordingly, the thirty month period for complying with the requirements of 35 U.S.C. 371, expired at midnight on 29 January 2001. (27 January 2001 was a Saturday.)

On 26 January 2001, applicants filed a transmittal letter for entry into the national stage in the United States. This letter was accompanied by a copy of the International Application as filed, an English translation thereof, and the requisite basic national fee. No oath or declaration as required under §371(c)(4) accompanied the transmittal.

On 05 March 2001, the United States Designated/Elected Office (PTO) mailed applicants a "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office" (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 C.F.R. 1.497(a) and (b) and the surcharge for providing the oath or declaration later than thirty months from the priority date were required. Applicants were given a **ONE (1) MONTH** period from the mail date of the Notifications to properly respond, with extensions of time obtainable under 37 CFR 1.136(a).

### DISCUSSION

On 05 September 2001, rule 47 applicant responded filing a declaration executed by the assignee on behalf of the nonsigning inventors with the instant petition (and fee) under §1.47, and a request for extension of time for response within the third month (and fee) to make the submission timely. The surcharge for filing the declaration later than thirty months from the priority date has been charged to counsel's Deposit Account No. 06-2375, pursuant to the accompanying authorization to charge any additional fees necessary. Rule 47 applicant asserts that status under §1.47(b) is proper because all of the inventors refuse to join in the application.

The petition and declaration have been reviewed and found not in compliance with §§1.47(b) and 1.497.

#### *Relevant Rules and Regulations*

Pursuant to 35 U.S.C. 118, 37 CFR 1.47(b) provides that:

Whenever all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for all the inventors. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, the fee set forth in §1.17(h), and the last known address of all of the inventors. An inventor may subsequently join in the application by filing an oath or declaration complying with §1.63.

In regards to the required proof of pertinent facts, MPEP 409.03(f) states:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (See MPEP §324).

MPEP 409.03(d) further states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

...

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

...

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In regards to the required oath or declaration, 37 CFR 1.497, provides in pertinent part:

- (a) he or she must file an oath or declaration that: ... (3) identifies each inventor and the country of citizenship of each inventor.
- (b)(2) If the person making the oath or declaration ... is not the inventor ..., the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state.

#### *Analysis*

Applicant complied with §1.47(b) by including on petition a statement that the filing under 1.47(b) is necessary to preserve the rights of the parties and to prevent irreparable harm, the petition fee and the last known address of both inventors. However, the petition does not include sufficient proof of proprietary interest or proof that the nonsigning inventors have refused to execute the declaration.

Applicant submitted signed assignments of the "invention" to Texas Pharmaceuticals, Inc., to show sufficient proprietary interest. These assignments are not acceptable to establish ownership and file the application under §1.47(b). They do not identify the application by application number. See 37 CFR 3.21 and MPEP §302.03. Nor was their filing preceded by or accompanied by a proper submission establishing ownership under 37 CFR 3.73(b). See 37 CFR 3.73 and MPEP §324. (Recordation of an assignment in the assignment records of the Office does not, by itself, permit the assignee to take action in the application, patent, or other patent proceeding interest.<sup>1</sup>)

To establish refusal, applicant provides a statement of facts of patent attorney Paul E. Krieger that:

The inventors in the above-referenced application have refused to execute a current Declaration in this application after numerous attempts have been made to have them execute one, although they signed one when the provisional application on which the above-identified application is based was filed. Their refusal stems from a dispute between them and the owner of the application, Texas Pharmaceuticals, Inc. ... The general attorney for Texas Pharmaceuticals, Inc. advised the undersigned that the inventors would not sign a current declaration and refused to accept letters by certified mail.

This statement of facts is not acceptable as it is not made by the person to whom the refusal(s) were purportedly made. In addition, the petition does not include a statement of facts by a person with first hand knowledge and supporting documentary evidence that a bona fide attempt was made to present the inventors with the application papers (specifications, claims, drawings and oath or declaration) prior to their alleged refusal. Applicant suggests but does not show that the inventors are unwilling to receive the application papers in order to sign the oath or declaration.

Furthermore, the declaration executed by the President of the assignee corporation is not in compliance with §1.497. The declaration does not include the citizenship of the nonsigning inventors<sup>2</sup>.

The deficiencies in this petition under §1.47(b) should be corrected, as follows:

- Applicant must submit acceptable proof of proprietary interest;
- A copy of the application papers should be sent to the last known address of the nonsigning inventors, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. Copies of documentary evidence of this

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<sup>1</sup> Applicant has also submitted as evidence of proprietary interest recordation form cover sheets used for recording of these assignments in the United States Patent and Trademark Form. Applicant is advised that a current review of Office records does not reveal that these assignments have ever been recorded in the Office.

<sup>2</sup> To be fully in compliance with §1.63, the declaration must state the full name, residence, post office address, and citizenship of the nonsigning inventor.

presentation, such as certified mail return receipts and cover letters of instructions, should be provided on renewed petition;

- Any renewed petition should include an affidavit or declaration of the pertinent facts by a person(s) with first hand knowledge; and
- A declaration for patent in compliance with §1.497.

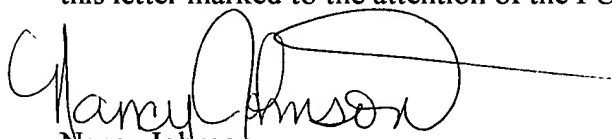
Of course, if inventors Bachynsky and Roy decide to join in the application. A declaration for patent executed by all of the inventors may be submitted as a proper reply to this dismissal.


### CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C., 20231, with the contents of this letter marked to the attention of the PCT Legal Office.

  
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